

**REMARKS**

Upon entry of the claim amendments, Claims 3-6, 8-20, 24-27, and 29-34 are all the claims pending in the application.

Independent Claims 9 and 14 have been amended as supported by, for example, Claim 5 and now-canceled Claims 2 and 7.

Claim 10 has been amended to render it consistent with amended Claim 9, from which it depends.

Amended Claim 11 is supported by, for example, page 6, lines 16-23, and the examples, such as page 7, lines 30-33, of Example 1.

No new matter has been added.

Referring to Section No. 3 at pages 2 and 3 of the Office Action, Claims 9-10 and 13 are rejected under 35 U.S.C. § 112, first paragraph.

In response, Applicants have amended independent Claims 9 and 14 to recite that the mineral filler is selected from the group consisting of oxides and nitrides of B, Al, Ti, Zn, Zr, Cr, and Fe, silicates, and mixtures thereof. Independent Claims 9 and 14 (and their dependents) satisfy each and every requirement of §112. Withdrawal of the §112 rejection is requested.

Referring to Section No. 5 at page 3 of the Office Action, Claim 11 is rejected under 35 U.S.C. § 112, second paragraph.

In response, Applicants have amended Claim 11 to recite that the copolymerizing is performed in a solvent selected from the group consisting of ortho-cresyl, meta-cresyl, para-cresyl, cresylic acid, N-methylpyrrolidone, dimethylacetamide (DMAC), and mixtures thereof, as supported by, for example, page 6, lines 16-23, and the examples, such as page 7, lines 30-33, of Example 1. Withdrawal of the §112 rejection is requested.

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Referring to Section No. 8 at pages 4 and 5 of the Office Action, Claims 3-7, 9-10, 12-14, 16, 19-20, 24-28, 30 and 33-34 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,401,787 (“Tonyali”).

Applicants respectfully traverse.

Amended independent Claims 9 and 14 (and their dependents) are not disclosed or suggested by Tonyali. For example, each of amended Claims 9 and 14 recites subject matter previously recited in Claim 2, which was not included in the present §102/§103 rejection. For at least this reason, Applicants respectfully request withdrawal of the §102/§103 rejection of Claims 3-7, 9-10, 12-14, 16, 19-20, 24-28, 30 and 33-34.

In addition, Tonyali is related to an entirely different field and has nothing to do with winding wires able to withstand partial discharges. Specifically, Tonyali’s disclosure is directed to flame retardant cables, and the compositions of Tonyali are based on polymers that are to be extruded on a cable in order to provide fire resistance to the cable. The insulation varnish of Claim 9, on the other hand, is to be coated on a wire in order to impact certain electrical characteristics to the wire.

For all of the foregoing reasons, Applicants respectfully request withdrawal of the §102/§103 rejection of Claims 3-7, 9-10, 12-14, 16, 19-20, 24-28, 30 and 33-34.

Referring to Section No. 9 at pages 5 and 6 of the Office Action, Claims 2, 5-6, 9-11, 13-14, 19, 23, 26-27, and 33 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,499,149 (“Berger”).

Applicants respectfully traverse.

Amended independent Claims 9 and 14 (and their dependents) are not disclosed or suggested by Berger. For example, each of amended Claims 9 and 14 recites subject matter previously recited in Claim 7, which was not included in the present §102/§103 rejection. For at least this reason, Applicants respectfully request withdrawal of the §102/§103 rejection of Claims 2, 5-6, 9-11, 13-14, 19, 23, 26-27, and 33.

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In addition, none of the presently applied references would have provided the motivation for one of ordinary skill in the art to modify the teachings of Berger and arrive at the subject matter of independent Claims 9 and 14.

For example, as mentioned above, Tonyali is related to an entirely different field and has nothing to do with winding wires able to withstand partial discharges. Accordingly, from the starting point of Berger, one of ordinary skill in the art, wondering how to provide a composition with increased resistance to partial discharge, would never have considered the teachings of Tonyali. For example, given Tonyali's relation to an entirely different field, it is necessarily silent about incorporating the mineral fillers recited in Claim 9 in a varnish composition in order to withstand partial discharge.

For all of the foregoing reasons, Applicants respectfully request withdrawal of the §102/§103 rejection of Claims 2, 5-6, 9-11, 13-14, 19, 23, 26-27, and 33.

Referring to Section No. 10 at pages 7 and 8 of the Office Action, Claims 3-7, 10, 12-16, 19-20, 24-28, 30, and 33-34 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,197,864 ("Borke").

Applicants respectfully traverse.

Amended independent Claims 9 and 14 (and their dependents) are not disclosed or suggested by Borke. For example, each of amended Claims 9 and 14 recites subject matter previously recited in Claim 2, which was not included in the present §102/§103 rejection. Indeed, Borke's teachings are specifically directed to olefin-alkoxy silane copolymers (Applicants refer, for example, to Borke's "Summary of the Invention"), whereas Claims 9 and 14 recite "a copolymer obtained from a thermoplastic or thermosetting resin selected from the group consisting of polyamide imide (PAI), polyester imide (PEI), polyimide (PI), polyester (PE), polyurethane (PU), polyvinylacetal (PVA), and mixtures thereof, and at least one alkoxysilane." For at least this reason, Applicants respectfully request withdrawal of the §102/§103 rejection of Claims 3-7, 10, 12-16, 19-20, 24-28, 30, and 33-34.

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Referring to Section No. 11 at pages 8 and 9 of the Office Action, Claims 8, 17-18, 29, and 31-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tonyali or Borke, each as applied above, and each in view of U.S. Patent Application Publication No. 2003/0087976 (“Bambara”).

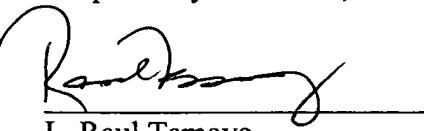
Applicants respectfully traverse.

Each of rejected Claims 8, 17-18, 29, and 31-32 depend from either Claim 9 or Claim 14. For reasons mentioned herein above, both Tonyali and Borke are deficient with respect to the subject matter recited in Claims 9 and 14. Bambara does not cure the deficiencies mentioned herein. Therefore, Applicants respectfully request withdrawal of the §103 rejection of Claims 8, 17-18, 29, and 31-32, at least by virtue of their dependence from Claim 9 or 14.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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